REMARKS

Applicant cancels claims 1-20 and replaces them with claims 21-47.

New independent claims 21, 30, 32, 36, 38 and 39 distinguish over the art of record by requiring the steps of or a data processor for determining the total file size of listed files as desired to be transferred from a client computer to a backup computer, or other similar language. The cited references do not disclose the foregoing limitation.

In the last Office Action, the Examiner alleged Saxon disclosed the foregoing feature. However, column 4, line 16-24 of Saxon indicates the backup is primary and secondary storage elements 26a and 26b in mass memory 14. There is no disclosure that mass memory 14 is a client memory or one of a plurality of client memories that is backed up by a backup memory. The Examiner's reliance on column 3, lines 55-67 for the disclosure of client computers is misplaced. There is nothing in this portion of Saxon discussing client computers. If the Examiner persists in this holding, he is requested to indicate how this or any other portion of Saxon discloses the foregoing limitation relating to determining total file size data of listed files desired to be backed up by a client computer. The quotation from column 7, lines 21-27 of Saxon which appears on page 4 of the Office Action refers to the capability of backing up the mass storage, rather than determining if the size of the file desired to be transferred from a client computer to a backup computer exceeds a limit.

The rejection of claim 8 as being upatentable over Saxon in view of Cane et al., U.S. Patent No, 5,765,173 need not be discussed in this response because there is no claim having the scope of original claim 8 now submitted.

Newly-submitted claims 21, 30, 32, 36, 38 and 39 distinguish patentably over the combination set forth in the previous Office Action of Morris U.S. Patent 5,812,017 and Ault et al. U.S. Patent 5,689,701. In rejecting former claims 10-16 as being obvious as a result of Morris and Ault, the Examiner admitted Morris does not teach summing plural client file sizes to obtain a summed file size total and comparing the summed file size total with a size quota limit. However, there is no basis to combine the Ault et al. reference with Morris to arrive at the combination set forth in the Office Action. Ault et al. has nothing to do with backing up client computers. Instead, Ault et al. is concerned with a system and a method for providing compatibility between distributed

file system name spaces and operating system pathname syntax. A proper rejection under 35 U.S.C. 103, wherein references are combined, requires some motivation or suggestion in the references to combine them. In the present case, there is no reason why one of ordinary skill in the art would have modified Morris as a result of Ault et al. The Examiner has merely cast around for references disclosing bits and pieces of applicant's claims and, after finding them, has combined them. The Examiner has offered no adequate rationale why one of ordinary skill in the art would have modified the Morris backup system as a result of Ault et al.

The submitted claims are also patentable over the combination of the previously cited Morris and Saxon patents. The combination is improper with regard to claims 21, 30, 32, 36, 38 and 39 because neither of the references discloses a method of operating a client computer or a client computer wherein the sizes of plural files desired to be backed up of the client computer are summed. As indicated previously, there is no indication that the mass storage of Saxon can be considered a client computer.

In rejecting claim 17, as previously submitted, the Examiner relied on a combination of Saxon and Chow et al. U.S. Patent 6,029,175. The Examiner relied on column 7, lines 45-50 of Saxon to disclose "determining a total size of all files of said client computer to be backed up." However, there is nothing in this portion of Saxon to indicate that the total size of a client computer is compared to anything. The inference is that the total size of the mass storage is compared to a maximum size threshold. The Examiner is requested to provide a basis for his conclusion that Saxon discloses comparing total size of a client computer with a maximum size threshold.

Claim 40, which corresponds to claim 18 as previously filed, is patentable over the combination of Morris and Rao et al. U.S. Patent 5,689,706. The Examiner relies on column 10, lines 60-64 of Morris to disclose maintaining a quota list comprising a list of files in a back-up area, which were backed up during a previous back-up operation. However, lines 60-64 say nothing of the sort. In this regard, column 10, lines 60-67 of Morris states:

> Thereafter, the process passes to block 42 which depicts the selection of the first file, by the client backup program, at the client 21 for examination. Next, as depicted by block 44, the file is examined to find out if it has been modified since last backup. If the file has been modified since last backup, it is then transmitted to the server 25, using the communication link 23 which connects the client computer 21 to the server 25, as depicted by block 46.

The Examiner also admits that Morris does not explicitly disclose modifying a copy quota list to list a plurality of files actually backed up by a backup operation after the backup operation has been completed. He relies on Rao et al. to disclose updating a master list file to an update file and a sort-merge operation that is periodically performed on an update file and a master list file to produce a new master file. However, such operation of Rao et al. is contrary to the Morris disclosure in column 11, lines 1-7. Morris indicates that if no file is left the backup session is terminated. Consequently, Morris found no reason to produce a new master list file. Consequently, there is no suggestion to modify Morris as suggested by the Examiner. In fact, the contrary is true because Morris indicates there is to be no updating.

The dependent claims included additional limitations relating to client computers, for example, that are not disclosed or made obvious by the references. In addition, many of the newly-submitted dependent claims are concerned with delta backup procedures for determining the desired file to be backed up to the backup computer for a particular client computer. While delta backup procedures are known, as stated in the present application as filed on page 19, delta backup procedures are completely opposite to the Saxon procedures which involve mass operation.

In view of the foregoing amendment and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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